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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,425	10/16/2003	Nardo B. Catahan JR.	OIC0242US	2230
60/975 7590 09/03/2009 CAMPBELL STEPHENSON LLP 11401 CENTURY OAKS TERRACE BLDG. H, SUITE 250 AUSTIN, TX 78758				
EXAMINER DANNEMAN, PAUL				
ART UNIT		PAPER NUMBER		
3627				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/688,425

**Applicant(s)**

CATAHAN ET AL.

**Examiner**

PAUL DANNEMAN

**Art Unit**

3627

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-18, 20-24, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-18, 20-24, 27 and 28 is/are rejected.
- 7) ☒ Claim(s) 11 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### DETAILED ACTION

##### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 June 2009 has been entered.

##### Response to Amendment

2. This action is in reply to Applicant's Request for Continued Examination filed on 11 June 2009.
3. Claims 1, 10, 13, and 22 have been amended.
4. Claims 1-6, 8-18, 20-24, 27 and 28 are pending and have been examined in this action.

##### Response to Arguments

5. The provisional statutory double-patenting rejection of Claims 1-6, 8-18, 20-24, 27 and 28 has been withdrawn as Applicants have amended the independent Claims 1, 10, 13, and 22 so that they are not co-extensive in scope with the claims of co-pending Application 10/688,094.
6. The rejection of Claims 1-6, 8 and 9 under 35 U.S.C. § 101 is respectfully withdrawn as Applicants have amended.
7. Applicants argue with respect to the rejection of Claims 1-6, 8-18, 20-24, 27 and 28 under 35 U.S.C. § 103(a) ***"Applicants respectfully submit that the cited portions of Knauss fail to disclose, at least, 'the common invoice data object format comprises at least one custom data element, and the custom data element is configured to allow customization of the common invoice data object format.'"*** The argument is moot as the independent claims have been amended and the Examiner has entered a new ground(s) of rejection.

***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. **Claims 1-6, 8-18, 20-24, 27 and 28** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 10/688,094. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are ***directed toward receiving and translating invoice data, to a common data format between two or more applications.***

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. **Claim 10** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 recites ***“A machine-readable storage medium; a data structure, wherein the data structure is stored on the machine-readable storage medium, and the data structure uses an extensible markup language format, the data structure comprising: at least one custom data element configured to allow customization of the common invoice data object format;...”*** It is unclear how a ***“data structure formatted in an extensible markup language format”*** and stored on a machine-readable storage medium is able to be configured to allow the customization of a ***“common invoice data object format”***. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Given the broadest reasonable interpretation the claimed invention is directed to non-statutory subject matter. Claim 10 recites ***“A machine-readable storage medium; a data structure, wherein the data structure is stored on the machine-readable storage medium, and the data structure uses an extensible markup language format, the data structure comprising: at least one custom data element configured to allow customization of the common invoice data object format;...”*** Applicant's specification in paragraph 49 discloses that the data structure stored on a machine-readable medium may also be downloaded as a computer program product and transferred between a remote

computer to a requesting computer by way of data signals embodied in a carrier wave and in paragraph 50 of the specification further discloses that the data structures and message structures may be stored or transmitted via a data transmission medium, such as a signal. Therefore, given the broadest reasonable interpretation the claim is directed to a data structure stored on a machine-readable storage medium which may also be a signal embodied in a carrier wave which renders Claim 10 as directed to non-statutory matter. Appropriate correction is required.

#### ***Claim Objections***

13. **Claims 11 and 12** are objected to because of the following informalities: The claims are dependent on a rejected claim which is directed toward non-statutory matter. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

14. **Claims 1-6, 8-18, 20-24, 27 and 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Knauss et al., US 7,043,687 B2 hereinafter known as Knauss and further in view of Schwarzhoff et al., US 6,591,260 B1 hereinafter known as Schwarzhoff and further in view of NPL\_XML\_Schema\_CE.

**As per Claims 1-6, 8-18, 20-24 and 27-28**, Knauss in at least FIG.3, Column 5, lines 64-67, and Column 6, lines 1-12 discloses a virtual document interface between applications and various types of messages or documents. Each application has a link to the virtual document interface, in which previously-defined mappings to variables of the virtual document are utilized in order to populate a target document or message, from a source document or message. Knauss in at least Column 6, lines 13-20 further discloses a system and method enabling automatic translation of EDI data to or from a self-describing markup language format such as XML, or an XML dialect, by way of a virtual document. Knauss in at least FIG.4 and Column 6, lines 36-51 further discloses links or mappings to the variables of a virtual document and to and from the source data model and the target data model.

Knauss does not specifically disclose that the invoice information being translated by a processor is comprised of at least one custom data element which is configured to allow customization and the essential data elements comprised of an identification data element, a base data element, a pricing data element, a shipping data element, and a line item details data element per se, however Knauss in at least Column 5, lines 30-37 still further discloses the use of an eXtensible markup language (XML) to allow the development of user-defined document types on the web. Knauss further discloses in Column 5, lines 38-48 that an EDI message is a data element and may be an invoice or purchase order. Each data element may represent a singular fact, such as a price, product, model number, and so forth. NPL\_Schema\_CE in page 1 and 3-6 discloses the use of Complex Elements and Empty Complex Elements which may be defined as they are needed by a schema. Schwarzhoff in at least Column 5, lines 33-67 further discloses an example of a business Purchase Order document with the use of a schema and redefining or adding an extension to one of the elements on a pre-existing document type. Schwarzhoff in at least Column 6, lines 1-17 further discloses on of the benefits of polymorphism is the expansion of the .Address> without a rewrite of the Purchase Order.

Knauss in at least Column 9, lines 48-58 and Column 10, lines 1-3 further discloses that under control of the translator, values are written into the variables of the virtual document from the source data model in a data stream to the target data model. Knauss in at least Column 9, lines 59-67 still further discloses that multiple target documents may be populated using data obtained from a single source document.

Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to combine the well know features of Knauss for translating data between a source and target with the well know features of XML Complex Elements with the well known features of Schwarzhoff to include the essential data elements (an identification data element, a base data element, a pricing data element, a shipping data element, and a line item details data elements) of a invoice by using Complex Elements and polymorphism when translating invoice information between applications with the motivation to allow the sharing of data between applications with somewhat similar data in various formats.

**Conclusion**

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627

31 August 2009

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627